

Application No. 09/617,678  
Amendment dated May 20, 2004  
Reply to final Office Action dated August 20, 2004

Attorney Docket No. 040071-080  
Page 2 of 4

### REMARKS

Claims 1-17 are pending, with claims 1 and 16 being in independent form.

In the final Office Action, claims 1-17 remain rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,308,051 to Atokawa ("Atokawa"). The Applicant believes the pending claims are allowable over the cited document for the following reasons.

Anticipation requires that every feature of the claimed invention be shown in a single prior document. *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994); *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). The pending claims positively recite features that are not described in the cited document.

For example, claim 1, recites, among other things, "a plurality of circuits . . . wherein . . . each circuit has a first filter characteristic that passes a first frequency band and substantially blocks a second frequency band when the device is in the first state; and each circuit has a second filter characteristic which substantially blocks the first and second frequency bands when the device is in the second state, wherein the second filter characteristic is a result of the device and the filter acting in combination". The Applicant respectfully asserts that Atokawa does not disclose a plurality of circuits having the recited filter characteristics.

The Office incorporates the text of the rejection raised in the first Office Action into the final Action and asserts that the bandwidth blocking filter circuit 27 on the transmission side of Atokawa comprises two, and hence a plurality, of the circuits recited in claim 1. Specifically, the Office asserts on page 2 of the final Action that capacitors C5, C1, C3, resonator 2, and diode D1 corresponds to a first of the recited plurality of circuits, while capacitors C6, C2, C4, resonator 3, and diode D2 correspond to a second of the recited plurality of circuits. However, as noted by the Applicant in the prior response, it appears that all of these elements of the bandwidth blocking filter circuit 27 work together to perform the bandwidth blocking filter function, and thus Atokawa does not describe the recited plurality of circuits.

In responding to the Applicant's prior arguments, the Office appears to affirm the Applicant's understanding of Atokawa in the paragraph spanning pages 7 and 8 of the final Action where it states that "the ON-condition of diodes D1 and D2 clearly anticipates the claimed limitation of [the first filter characteristic of the circuit] . . . and the OFF-condition of diodes D1 and D2, on the other hand clearly anticipates the

Application No. 09/617,678  
Amendment dated May 20, 2004  
Reply to final Office Action dated August 20, 2004

Attorney Docket No. 040071-080  
Page 3 of 4

claimed limitation of [the second filter characteristic of the circuit]". Thus, in the response to the Applicant's prior arguments, the Office is now reading the recited "each circuit" of the plurality of circuits on a portion of Atokawa's bandwidth blocking filter circuit 27 that includes both devices (diodes) D1 and D2.

Although inconsistent with the assertion on page 2 of the final Action (where the Office asserts that diodes D1 and D2 are part of separate circuits of a plurality of circuits), the Office's characterization of Atokawa on pages 7 and 8 of the final Action is consistent with the arrangement shown in FIG. 1 of the cited document. The arrangement in FIG. 1 shows both the diodes D1 and D2 being coupled to the same control input "CONT1". Consequently, the diodes D1 and D2 must be either both on or both off. Indeed, Atokawa describes at column 6, lines 46-55 that:

When the positive voltage as the control voltage is applied to the voltage control terminal CONT1, the PIN diodes D1, D2 are in the ON-condition. Thus, the variable bandwidth capacitors C3, C4 are respectively grounded through the PIN diodes D1, D2, two attenuation polar frequencies are reduced, and the passing band of the transmitting circuit 25 becomes 887-901 MHz. On the contrary, when the negative voltage is applied as the control voltage, the PIN diodes D1, D2 are in the OFF-condition. The variable bandwidth capacitors C3, C4 are thus in the open condition, two attenuation polar frequencies are both increased, and the passing band of the transmitting circuit 25 becomes 915-925 MHz.

Consequently, if the bandwidth blocking filter circuit 27 were broken up into separate circuits as asserted by the Office, the individual parts would not possess the filter characteristics recited in claim 1. Nevertheless, the Applicant requests that if this ground of rejection is maintained, that the finality of the rejection be withdrawn, and a new Action be issued providing an explanation to support the assertion that capacitors C5, C1, C3, resonator 2 and diode D1 operate independently of capacitors C6, C2, C4, resonator 3 and diode D2, and independently provide the recited filter characteristics, so that the Applicant has a full and fair opportunity to respond to this interpretation of Atokawa.

Accordingly, because Atokawa does not describe a plurality of circuits, each having the filter characteristics recited in claim 1, the claim is believed not to be anticipated by the cited document for at least this reason. Claims 2-15 variously depend from claim 1, and hence, are believed allowable for at least the same reasons that claim 1 is considered allowable.

Application No. 09/617,678  
Amendment dated May 20, 2004  
Reply to final Office Action dated August 20, 2004

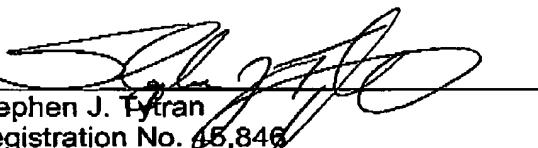
Attorney Docket No. 040071-080  
Page 4 of 4

Regarding method claim 16, this claim recites the first and second filter characteristics discussed above with respect to claim 1, and hence, is believed to be allowable over Atokawa for similar reasons to those discussed above in traversing the rejection of claim 1. Moreover, claim 17 depends from claim 16, and is considered allowable for these same reasons as well.

For the foregoing reasons, the Applicant believes the application is in condition for allowance, and respectfully requests Notice thereof at an early date. If any questions remain, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

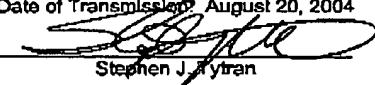
Stephen J. Tyran  
Registration No. 45,846

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(919) 941-9240

Date: August 20, 2004

I hereby certify that this correspondence is being sent by facsimile transmission to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 to the following facsimile number:

Facsimile Number: 703 872 9306  
Date of Transmission: August 20, 2004

  
Stephen J. Tyran